

REMARKS

Claims 1-10, 12-13, 16-19 and 21-24 were pending in the present application. Claims 11, 14-15, and 20 were previously withdrawn due to restriction requirements. Independent Claims 1, 19, and 23 have been amended to clarify claimed subject matter and/or correct informalities. Support may be found at least at [0004], [0005], [0012], [0019], [0022], [0024], [0025], and [0027]. No new matter has been introduced by these amendments.

Claims 6 and 7 have been cancelled without prejudice, leaving Claims 1-5, 8-10, 12-13, 16-19, and 21-24 for consideration upon entry of the present Amendment. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

Rejections Under § 103: A., B., and C.

A. Claims 1-2, 4-10, and 16-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,056,859 to Pace (hereinafter, "Pace") in view of U.S. Patent No. 5,582,392 to Bajric, et al. (hereinafter, "Bajric"). Applicant respectfully traverses these rejections.

Without conceding the propriety of the stated rejections, and only to advance the prosecution of this application, Applicant has amended **independent Claim 1**, to clarify further features of the subject matter. Independent Claim 1 now recites:

An apparatus for running wire, the apparatus comprising:
a projectile launcher, comprising:
a housing including a cylindrical tube having an open proximal end
and a closed distal end;
a biasing member attached to a piston comprising a concave face
within the cylindrical tube; and
a locking member for retaining the piston in a biased position and for
triggering release of the piston,
a pull string within the cylindrical tube,

a deformable projectile within the cylindrical tube, wherein the deformable projectile is adapted to connect to the pull string;

wherein the piston cradles the projectile, accelerates along the cylindrical tube upon release and propels the pull string attached to the deformable projectile toward a target, and

wherein the projectile and the pull string are not connected to the projectile launcher upon release of the piston.

Turning first to **independent Claim 1**, Applicant submits that the evidence relied upon by the Office does not support the rejections made under 35 U.S.C. §103(a). All of the §103(a) rejections rely on Pace and Bajric, as the primary and secondary references. As described in more detail below, Applicant submits that Pace and Bajric do not disclose, teach, or suggest the features "a piston comprising a concave face; a deformable projectile within the cylindrical tube, the piston cradles the projectile, propels the pull string attached to the deformable projectile toward a target, and the projectile and the pull string are not connected to the projectile launcher upon release of the piston", as recited in Claim 1.

The evidence shows Pace describes that as the dart moves forward, **the line is fed into the barrel slot** and is guided by the **slotted piston** (col. 1, lines 64-66). Bajric describes a **rod projectile** is insertable into the bore of the barrel (col. 2, lines 60-61) and the **rod has an elongated cylindrical shaft** (col. 2, line 66). This evidence is insufficient to support a prima facie case of obviousness of the features recited in Claim 1. As Pace and Bajric do not disclose, teach or suggest all the claim features, alone or in combination, Applicant submits that the claims are allowable over the pending obviousness rejections.

Next, the Office states the projectile and the pull string are connected to the projectile launcher in Pace but that Bajric discloses the pull string may be dispensed separately from the projectile launcher. The Office has failed to establish a motivation sufficient for one of ordinary skill in the art to combine Pace and Bajric. The motivation provided by the Office

"to simplify the manufacture of the projectile launcher" is too general because it could cover almost any alteration contemplated of Pace and does not address why this specified proposed modification would have been obvious. Additionally, the cited references neither teach nor suggest that dispensing the pull string separately from the projectile launcher in Pace would simplify the manufacture of the projectile launcher. This rejection is improper and is based on hindsight.

Dependent Claims 2-5, 8-10, 12-13, and 16-18, and 21-22 depend directly or indirectly from Claim 1 and thus are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 1, are not disclosed by Pace or Bajric.

Turning now to **Independent Claim 19**, which has been amended to clarify subject matter, recites:

An apparatus for running wire, the apparatus comprising:
projectile launching means, comprising:
a piston comprising a concave face;
 biasing means for accelerating a the piston, wherein the biasing means is attached to the piston; and
 locking means for retaining the piston in a biased position and for triggering release of the piston, wherein the piston accelerates upon release; and
a pull string;
a deformable projectile attached to the pull string;
 wherein the deformable projectile is nested to the concave face of the piston;
 wherein release of the piston propels the pull string attached to the deformable projectile toward a target; and
 wherein the deformable projectile and the pull string are not connected to any portion of the projectile launching means upon release of the piston.

Independent Claims 19 recites features similar to those in Claim 1 and hence benefits from the same arguments directed above to Claim 1. Applicant requests the §103 rejection be withdrawn.

B. Claims 12-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,056,859 to Pace (hereinafter, "Pace") in view of U.S. Patent No. 5,582,392 to Bajric, et al. (hereinafter, "Bajric") and further in view of U.S. Patent No. 6,732,725 to Doud (hereinafter, "Doud"). Applicant respectfully traverses these rejections.

Both **dependent Claims 12 and 13** depend from independent Claim 1, which was discussed above. Without conceding that Doud provides the teaching for which it was cited in the Action, Applicant submits that Doud does not teach what is missing from Pace and Bajric to support a §103 rejection of Claim 1.

Furthermore, the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to combine Pace and Doud. The motivation provided by the Office "to guide the movement of the projectile and to further provide a convenient means of retracting the piston into the housing against the bias of the spring" is not well reasoned. Pace already uses a barrel with a dart to guide movement of the projectile and the slotted piston is retracted into the housing by the rod. Thus, there is no motivation to combine the two references. This rejection is improper. Applicant requests the §103 rejection be withdrawn.

C. Claims 3 and 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,056,859 to Pace (hereinafter, "Pace") in view of U.S. Patent No. 5,582,392 to Bajric, et al. (hereinafter, "Bajric") and further in view of U.S. Patent No. 6,889,982 to Gove (hereinafter, "Gove"). Applicant respectfully traverses these rejections.

Dependent Claims 3, 21, and 22 depend from independent Claim 1, which was discussed above. These claims are allowable as mentioned.

Independent Claim 23 has been amended to clarify subject matter and now recites:

An apparatus for running wire, comprising:
a housing comprising an open proximal end and a closed distal end;
a piston comprising a concave face, the piston at least partially enclosed within the housing;
a coil spring, the coil spring attached to the piston and at least partially enclosed within the housing;
a locking device, comprising:
a lock; and
a trigger, the lock configured to hold the coil spring in a compressed position and the trigger configured to release the coil spring from the compressed position when the trigger is activated; and
a projectile, comprising:
a deformable sack, wherein the deformable sack is inelastic; weighted material;
an attaching mechanism configured to attach a wire to the projectile; and
a locating beacon;
wherein the projectile is configured to nest within the concave face of the piston and to sit within the housing;
wherein the projectile is propelled upon activation of the trigger; and
wherein the projectile and the wire are entirely disconnected from the apparatus upon activation of the trigger and exit from the housing.

Applicant's claimed projectile is "a deformable sack, wherein the projectile is configured to nest within the concave face of the piston and to sit within the housing comprising an open proximal end and a closed distal end", as recited in Claim 23.

Applicant traverses the rejection of Claim 23 because Gove is non-analogous art. For the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute "analogous art" (MPEP §2141.01(a)). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved.

Regarding the first prong of the above analysis, Gove is not from the same field of endeavor as Applicant's subject matter. Gove is directed to a gaming apparatus. Gove describes **gaming projectiles** which may be closed bags filled with granular material (beanbags), irregular shaped members, sticks or batons (col. 6, lines 16-19). In contrast, Applicant's subject matter pertains to running wires through ceiling openings. Thus, Gove is clearly not from the same field of endeavor as is Applicant's subject matter.

Turning now to the second prong of the above analysis, Gove is not reasonably pertinent to the particular problem with which Applicant is involved. As noted above, Gove is directed to a gaming apparatus. In contrast, Applicant's subject matter pertains to using an apparatus to run wire through ceiling openings. Even assuming that Gove's gaming projectile connected by an elongate pliable coupling structure (col. 10, lines 30-32) is used as a projectile launcher, Gove's device does not address the problem of propelling the projectile toward a target through ceiling openings for efficiency purposes. Rather Gove's gaming projectile connected by an elongate pliable coupling structure is to toss the projectile toward a crossbeam leading to wrapping engagement (col. 10, lines 37-40). As such, Gove is not reasonably pertinent to the particular problem addressed by Applicant.

Because it fails both prongs of the above analysis, Gove is non-analogous art, and any §103 rejection based on Gove is improper. On at least this basis, Applicant requests reconsideration and withdrawal of the stated § 103 rejections of Claim 23.

In addition, the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to combine Pace and Gove. The motivation provided by the Office "to provide a convenient and inexpensive projectile that will reduce possible harm to users and will be readily found after launch" is not sound. This rejection is improper as the

projectile is directed away from the user, without a need to reduce possible harm to users. Applicant respectfully requests the §103 rejection be withdrawn.

Dependent Claim 24 depends directly from Claim 23 and thus is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features that, in combination with those recited in Claim 23, are not disclosed by Pace or Bajric or Gove.

Conclusion

Claims 1-5, 8-10, 12-13, 16-19, and 21-24 are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of the subject application. If any issue remains unresolved that would prevent allowance of this case, the Office is requested to contact the undersigned attorney to resolve the issue.

Respectfully Submitted,
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Dated: 10-31-2006

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